THE AMENDMENT

Claims 1-18, 20-38, 40-42 and 47-51 are in the case. Claims 43-46 and 52-55 have been canceled. Claims 47-48 and 50-51 have been amended.

Claims 47-50 are now dependent from claim 9 and the amendments to claims 47-48 and 50 are made to provide proper antecedent basis to claim 9. The amendment to claim 51 (now dependent from claim 1) is to provide proper antecedent basis to claim 1.

The amendment to the Specification at page 2 is to correct a typographical error in the issued patent number in the update to the Cross References to Related Applications.

Applicants respectfully submit that the Amendment does not introduce new matter and request that the Amendment be entered.

REMARKS

1. Brief Summary of the Invention

Applicants' invention relates to a gaming device that includes a gaming device housing having a cage-type display container coupled thereto. At least one moveable object is configured to move within the cage-type display container and the container may be rotatable. The moveable object comprises at least one moveable object symbol. A controller is provided that is in communication with at least one controller selectable object. The controller selectable object comprises at least one controller selectable object symbol that is substantially similar in appearance to the moveable object. The controller selectable object may be displayed to the player and provides an illusion to the player that the controller selectable object is the moveable object. A game display is also provided and may be in communication with the controller. The

game display is configured to display a display symbol in at least one display position. A game outcome at least partially depends on the display position of the display symbol.

2. Obviousness-type Double Patenting: rejection of claims 1, 5-19, 32, 36-43, 45, 47 and 51 over claims 22-36 of U.S. 6,817,945 in view of Rivero (U.S. 4,871,171).

Claims 1, 5-19, 32, 36-43, 45, 47 and 51 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 22-36 of U.S. 6,817,945 in view of Rivero. Applicants respectfully traverse this rejection and request withdrawal of the obviousness-type double patenting rejection in view of the terminal disclaimer (PTO/SB/26) filed with this response; note that claims 43 and 45 have been separately canceled.

3. Obviousness-type Double Patenting: rejection of claims 20 and 25-31 over claims 29-39 of US 6,338,678 in view of Rivero (U.S. 4,871,171).

Claims 20 and 25-31 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 29-39 of U.S. 6,338,678 in view of Rivero (U.S. 4,871,171). Applicants respectfully traverse this rejection and request withdrawal of the obviousness-type double patenting rejection in view of the terminal disclaimer (PTO/SB/26) filed with this response.

4. Rejection of claims 1-55 under 35 USC 103(a) as being obvious over Glasson et al. (US Patent Application Publication 2002/0177478) in view of Rivero (U.S. 4,871,171).

Claims 1-55 stand rejected as being obvious under 35 USC 103(a) over Glasson *et al.* in view of Rivero. Applicants respectfully traverse this rejection for the reasons discussed below; note that claims 43-46 and 52-55 have been canceled.

Glasson appears to disclose animated representations for playing a bingo game involving display of selected bingo numbers [*not bingo balls*]. Element "48" of Glasson corresponds to a display of "the last number drawn". This does correspond to "controller selectable object (prize ball)" of Applicants' claims. Element "46" is a representation of a bingo board that indicates drawn bingo numbers (indicia). This is not the same as a display of the drawn bingo balls themselves. Thus, Glasson provides no "illusion that the selected balls are actually being withdrawn from the barrel and displayed as such."

Glasson further provides for an animated display of bingo balls being mixed in a barrel-like container (¶ 41). However, there is no connection between the representation of bingo balls in the container and elements "46" or "48" that would give the "illusion that the selected balls are actually being withdrawn from the container and displayed as such" (as required by Applicants' claimed invention).

Rivero appears to disclose a lottery game system involving a rotating container that simulates random selection of a numbered ball, "giving the impression that the ball has been counted" [*not displayed*] (see col 3, lines 30-34). Rivero does not disclose or suggest that the displayed (action) ball in the container and the prize display (ball) are the same. Instead, Rivero releases display balls into a transparent tube (and returns them to the container; see abstract and

col 3, lines 40-55). The released display balls do not end up as part of the prize "display", only an electronic simulation of the ball number is subsequently presented in the prize window 9 (see figure 1 and col 3, lines 1-3).

The Office contends that "it would have been obvious to modify Glasson's container such that it is in the form of ... image of rotatable cage-like display container" (based on the disclosure of Rivero) and allegedly arrive at Applicants' claimed invention. However, Applicants' claimed invention requires involvement of a controller selectable object substantially similar in appearance to the moveable object, where the controller selectable object displayed to the player "provides an illusion that controller selectable object (prize ball) is (same as) the moveable object (displayed action ball)."

Contrary to the Office's contention, there is no basis or incentive for one of ordinary skill in the art to combine the teachings of Glasson and Rivero, since Rivero actually teaches away from the ball-container requirements of Glasson. Glasson requires the bingo balls to be drawn from the container so that the balls are not replaced, so that no bingo numbers can be drawn more than once (see ¶ 41 of Glasson). In contrast, the container of Rivero (abstract and col 3, lines 40-55) is configured to release a ball from the container into a tube and to return the (same) ball back into the container during rotation of the container (thus allowing for the possibility that the same number may be drawn more than once). This is in keeping with the "lottery" game aspect of Rivero, as opposed to the "bingo" game format taught by Glasson. Since the container of Rivero is configured to provide selection and replacement of the ball, which is in direct conflict with the requirements of Glasson, one of ordinary skill in the art would have no incentive "to modify Glasson's barrel-like container ... in the form of ... a mechanical or video

image of [a] rotatable cage-like display container" based on the teachings of Rivero to arrive at Applicants' claimed invention, as alleged by the Office.

Given that the modification of Glasson, based on Rivero, as proposed by the Office would result in Glasson's game allowing for the same number to be selected more than once, Applicants submit that the resulting modification would render Glasson's game unsatisfactory for its intended purpose, i.e., a bingo game where each number is only selected once. As a result, there is no suggestion or motivation to make the modification as proposed by the Office, nor is there any suggestion of the desirability of the combination/modification (see MPEP 2143.01). Selectively picking one feature from among several features in a secondary reference in order to combine with or modify a device in a primary reference without considering the consequences of all the features of secondary reference as a whole (especially when the combination or modification would result in conflicting outcomes) does not provide incentive or motivation for one of ordinary skill in the art to combine the references.

Even if Glasson and Rivero were to be combined, there is no teaching or suggestion in either Glasson or Rivero of a device that provides the "illusion that the selected action balls are actually being withdrawn from the container and displayed as such," as required by Applicants' independent claims 1, 20 and 32 (and corresponding dependent claims). An advantage of this feature, provided by Applicants' invention, is further described at page 47 (¶ 197, in reference to Figure 22) of Applicants' specification: "... is that a game player can actually see cage 701 rotating and the display balls being mixed with the cage. The rotating cage enhances the illusion that the selected prize balls are being withdrawn from the cage and displayed. Display window 710 also enhances the illusion that the selected prize balls are being withdrawn from cage 701

and displayed." In this fashion, actual (prize) balls are displayed to the player to indicate the outcome of the game or the value of a prize. In contrast, the cited prior art does not involve any actual physical balls to display the outcome of a game; thus, these games tend to be less desirable because game players prefer to see physical objects rather than electronic simulations of the physical objects. In addition, players may tend to believe that a game device is misleading when the device displays a simulation rather than the object itself.

Based on the arguments presented above, Applicants submit that the Office has not established *prima facie* obviousness and that the claimed invention is not obvious over Glasson in view of Rivero and respectfully request withdrawal of the rejection under 35 USC 103(a).

5. Rejection of claim 52 under 35 USC 112 as failing to comply with the enablement requirement.

Claim 52 stands rejected as failing to comply with the enablement requirement under 35 USC 112. Applicants have canceled claim 52 and the rejection is moot.

CONCLUSION

For all of the above reasons, Applicants respectfully submit that the present application is in condition for allowance. If the Examiner has any questions regarding the application or this response, the Examiner is encouraged to call Applicants' attorney, Ian F. Burns, at (775) 826-6160.

Respectfully submitted,

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